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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,507	06/23/2005	Basile Bonnemaire	033246-0170	6624

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EXAMINER	
SINGH, SUNIL	
ART UNIT	PAPER NUMBER
3672	
MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/540,507	BONNEMAIRE ET AL.	
	Examiner	Art Unit	
	Sunil Singh	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 November 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-16 are ambiguously constructed and indeterminate in scope because they purport to claim both a product and method of using the product in a single claim.

Claims 1-16 are confusing because claim 1 the "non-operative" position is when the riser is disconnected (see lines 3-5); however, at lines 9-10, the riser is connected in the "non-operative" position.

Claims 1-16 are confusing. Claim 1 calls for the protection means to include stretching or tensioning means; however it also calls for the stretching or tensioning means to be attached to the protection means. It is clear that the protection means cannot include the stretching or tensioning means and at the same time be attached to it.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-16 are rejected under 35 U.S.C. 101 because they improperly embrace both product or machine and process. The language of 35 U.S.C. 101 sets forth statutory classes of invention in alternative only. See Ex parte Lyell, 17 USPQ2d 1549.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 7114885. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both call for a riser comprising protection means and stretching or tensioning means.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Loset et al. (US 7114885) or Wipo '895.

Loset et al. and Wipo '895 both call for a riser (18) comprising protection means (20) and stretching or tensioning means (22).

9. Claims 1,2,4,6,7,8,9,11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Butler et al. (US 5169265).

Butler et al. discloses a riser (14) comprising protection means (60) and stretching or tension means (26,32,44,46). Collar (36). Chains and or wires ((84),see col. 6 line 23+). Coating (40,40a). The protection means are stacked.

Claim Rejections - 35 USC § 103

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. in view of Ortloff et al. '919.

Butler et al. discloses the invention substantially as claimed. However, Butler et al. is silent about the riser (protection means) being suspended from a turret buoy. Ortloff et al teaches a riser (protection means) being suspended from a turret buoy (see Figs. 3, 5). It would have been considered obvious to one of ordinary skill in the art to modify Butler et al. by having the riser suspended from a turret buoy as taught by Ortloff et al. since such a modification allows for weathervane of the vessel.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. in view of Poldervaart '781

Butler et al. discloses the invention substantially as claimed. However, Butler et al. is silent about the riser being moored to the seabed. Poldervaart teaches the riser (stretching means) being moored (3) to the seabed. It would have been considered obvious to one of ordinary skill in the art to modify Butler et al. by having the riser (stretching means) moored to the seabed as taught by Poldervaart since such a modification stabilizes the riser.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. in view of Bennett '053

Butler et al. discloses the invention substantially as claimed. However, Butler et al. is silent about the protection means is conical and truncated. Bennett teaches protection means that is conical and truncated (see Fig. 8). It would have been considered obvious to one of ordinary skill in the art to modify Butler et al. to have conical and truncated protection means as taught by Bennett since such a modification is a mere design choice.

Response to Arguments

13. Applicant's arguments filed 11/27/07 have been fully considered but they are not persuasive. Applicant argues that Loset does not disclose the protection means terminated above the sea bed **when** the riser is connected to the vessel. It should be noted that claims 1-16 are directed to a product and not a method of using. It is clear that the product includes a riser and protection means. The protection means being formed of a plurality of separate units suspended from each other and a stretching or tensioning means attached to a lower end of the unit. Loset clearly meet the structural limitations of a riser and protection means. It is important for applicant to recognize that the claims are not directed to how the structure is used but by the structure itself.

Applicant argues that Butler does not teach a protection means terminated above the sea bed **when** the flexible riser is connected to the vessel below the vessel during operations and where a stretching means or a tensioning means is attached to the lower end of the protection means and also terminated above the sea bed. It should be

noted that claims 1-16 are directed to a product and not a method of using. It is clear that the product includes a riser and protection means. The protection means being formed of a plurality of separate units suspended from each other and a stretching or tensioning means attached to a lower end of the unit. Butler clearly meets the structural limitations of a riser and protection means. The structure taught by Loset and Butler meet the structural limitation called for in claims 1-16. It appears that applicant is relying on how the product is used for patentability. It should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (571) 272-7051. The examiner can normally be reached on Monday through Friday 10:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sunil Singh/
Primary Examiner, Art Unit 3672

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Primary Examiner
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SS

1/26/08